



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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00/068,437 00/04/99 GILBERTSON

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IM31/0329

EXAMINER
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CHERRER, C.

ART UNIT	PAPER NUMBER
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1761

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DATE MAILED:

03/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/368,437

Applicant(s)

Goldstein et al

Examiner

Curtis E. Sherrer

Group Art Unit

1761



☒ Responsive to communication(s) filed on Jan 22, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 25-43 and 68-74 is/are pending in the application

Of the above, claim(s) 25-28, 32-43, and 68-71 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 29-31 and 72-74 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### Part III DETAILED ACTION

#### *Election/Restriction*

1. Claims 25-28, 32-43 and 68-71 are withdrawn from further consideration by the examiner. 37 CFR 1.142(b) as being drawn to a non-elected products and non-elected species of the elected process. Election was made **without** traverse in Paper No. 6.
2. Applicant's election without traverse of Group I in Paper No. 6 is acknowledged.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

#### *Priority*

4. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. The current status of all nonprovisional parent applications referenced should be included.
5. This application discloses and claims only subject matter disclosed in prior Application No. 08/838,217, filed 04/03/97, and names an inventor or inventors named in the prior application. Accordingly, this application may constitute a continuation or division. Should

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applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

*Drawings*

6. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

*Claim Rejections - 35 USC § 112*

7. Claims 29-31 and 72-74 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a kettle hop **flavorant**, does not reasonably provide enablement for a kettle hop **essence and flavorant**. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. The specification states that the glycosides, which have been extracted from the hops are "non-volatile [in] character" (page 14, lines 25 and 26) and are "responsible for kettle hop flavor" (page 17, lines 18 and 19). Therefore, only those claims that are directed to the conversion of the glycosides to aglycones or have had hop oil added to the flavorant are considered to produce a hop essence and flavorant. It is noted that Applicants define "essence" as "compounds which can be perceived by smell" (page 9, lines 10 to 16).

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8. Claims 29-31 and 72-74 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 29 and 72 are indefinite because the scope of the phrase "partially converted" is unknown.

10. Claim 72 is also indefinite because of the scope of the phrase "a portion of free carbohydrates" is unknown. Further, the scope of the phrase "free carbohydrates" is unknown.

*Claim Rejections - 35 USC § 102*

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 29-31 and 72-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Vitzthum et al (U.S. Pat. No. 4,104,409)(hereinafter Vitzthum).

13. The claims broadly require a composition containing aglycones that are found in hops. Some of the limitations are of a process nature and are not given patentable weight without a showing of their criticality. Dependent claims 31 and 74 require the presence of some additionally specified hop components.

14. Vitzthum teaches the extraction of resins and oils from hops using CO<sub>2</sub>. The extracted hops are then treated with water to remove the remaining tannins (col. 3, lines 8-65), which would inherently include the glycosides and aglycones. Further, this portion of the patent teaches that the aqueous extract can be added to the oils that were extracted in the first CO<sub>2</sub> extraction step. This teaching is considered to anticipate the product claims, whereby water soluble compounds are extracted from hops and concentrated.

15. The Office does not have the facilities for examining and comparing Applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed are functionally different than those taught by the prior art and to establish patentable differences. See *In re Best*, 562 F.2d 1252, 195 U.S.P.Q. 430 (CCPA 1977); *Ex parte Gray*, 10 U.S.P.Q.2d 1922, 1923 (BPAI).

### ***Conclusion***

16. No claim is allowed.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 8:00 to 5:30. The fax phone number for this Group is (703)-305-3602.

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18. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

A handwritten signature in black ink, appearing to read 'C. E. Sherrer', with a stylized, flowing script.

Curtis E. Sherrer  
Primary Examiner  
March 22, 2001